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Remarks

Claims 1 through 6 remain pending in the application.

Claim Rejections – 35 U.S.C. §103 (Chu)

The Office Action rejects claim 1, 5 and 6 as obvious over Chu et al., Method and Apparatus for Severing and Capturing Polyps, U.S. Patent 6,010,512 (Jan. 4, 2000). The Office Action Asserts Chu discloses the system and method claimed by the Applicant, but fails to disclose a heating element. Further, the Office asserts it would have been obvious to modify Chu by incorporating a heating element along the snare cable which would be tantamount to the Applicant's claimed invention. The Office Action asserts the motivation to one of ordinary skill is to provide the added benefit of cauterizing along the snare cable providing a cleaner cut and detachment of the polyp. The Office Action is failing to fully consider the Applicant's claim limitations. The Applicant respectfully traverses the rejection.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. In re Vaack, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Chu fails to teach, suggest or disclose all the claim limitation of the Applicant's claimed invention. The Applicant claims in Claims 1, 5 and 6, *inter alia*, a heating element

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disposed on at least one of the jaws and located between the pair of jaws. In Chu, the severing device 63 comprising an expansible snare 70 is coupled at its proximal end to the cable 65. (Col. 7, lines 12-24). Chu utilizes the cable 65 to provide monopolar cauterization of the polyp. (col. 7, lines 34-37) The snare in Chu is used as a monopolar heating element. Chu does not dispose a heating element on at least one of the jaws as claimed by the Applicant. It should be further noted that the cross-sectional view in Figure 13 depicts the snare cable 65 and the hypotube 66 found in Figure 12. The cable 65 is used to extend and retract the snare 70. (col. 7, lines 25 -60). The hypotube 66 is used to operate the capturing device 64 having a forceps-needle combination. The capturing device and the snare in Figure 12 are not manipulated by the same wire and are not in electrical communication with one another. (Figure 12). They are being controlled by two different wires, namely the cable 65 and the hypotube 66. The cable 65 is connected to the electrical plug to provide monopolar cauterization and the hypotube is not. (col. 7, lines 34-37). Even if the leg members 40 in Figure 5 were used as a heating element as suggested by the Office Action, a heating element would not located between the pair of jaws as claimed by the Applicant.

Furthermore, the Applicant's claim limitations in Claim 1, 5 and 6 include, *inter alia*, a snare cable routed through the pair of jaws. In Figure 5 of Chu, the leg members 40 extend from opposed central portions of the snare. (col. 6, lines 20-34). The leg members are not routed through the jaws as claimed by the Applicant. The legs in Chu are part of the snare and extend from it. (See figures 5 and 6). Chu explicitly states the extending legs are secured to the snare extending from the distal end of the cable. (col. 5, lines 59-66). Chu also provides alternative configurations in Figures 12 -18 where the capturing device 64 is provided separately from the snare. However, nowhere in Chu is it disclosed or suggested to route the snare through the jaws.

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Chu is structurally different than the Applicant's claimed invention and as a result, Chu fails to disclose claim limitations found in the Applicant's claimed invention.

The Office Action's arguments found on page 6 and the top of page 7, that the heating elements include the snare and the jaws, further support the Applicant's assertion that Chu does not disclose a snare cable routed through the pair of jaws. The only way the snare and jaws disclosed in Chu's Figure 5 could provide cauterization is if they were part of the same structure in electrical communication with one another. Hence, the snare and the legs disclosed in Chu would act as an electrode. This would be consistent with the embodiments disclosed in Figure 5 of Chu, but supports the Applicant's assertion that a snare cable routed through the pair of jaws is not disclosed in Chu.

The Office Action further asserts that disposing a heating element on at least one of the jaws is obvious over Chu in view of Fleury, Jr., Surgical Snare, U.S. Patent 4,326,530 (Apr. 27, 1982). Fleury, however, does not disclose disposing a heating element on a jaw. Fleury uses a snare of conductive material as a heating element. (col. 2, line 41-61). No jaws can be found in Fleury. Fleury simply teaches use of a snare as a heating element which is consistent with Chu's use of the snare as heating element. This, however, is not consistent with the Applicant's claimed invention.

Since Chu and Fleury, both singularly and in combination, fail to disclose, teach or suggest several claim limitations found in the Applicant's claimed invention, they do not render obvious the Applicant's claimed invention. Therefore, withdrawal of this rejection is respectfully requested.

Claim Rejections – 35 U.S.C. §103 (Chu & Stati)

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The Office Action rejects claim 4 as obvious over Chu et al., Method and Apparatus for Severing and Capturing Polyps, U.S. Patent 6,010,512 (Jan. 4, 2000) in view of Stati et al., Method of Inhibiting Blood Clot on Silicone Rubber Medical Devices, U.S. Patent 3,829,903 (Aug. 20, 1974). The Applicant respectfully traverses this rejection.

The requirements for establishing a prima facie case of obvious are discussed *supra*. Stati is directed towards a method of inhibiting blood clots on the surface of silicone rubber medical devices. Stati fails disclose a pair of jaws extending out of the distal end of the catheter and a heating element disposed on at least one of the jaws and located between the pair of jaws in its specification. Chu also fails to disclose a pair of jaws extending out of the distal end of the catheter and a heating element disposed on at least one of the jaws and located between the pair of jaws as previously discussed.

Since Chu and Stati each fail to disclose at least one common limitation recited in claim 4, it follows that the combination of both references fails to disclose the invention recited in claim 4. As such, claim 4 is patentable over Chu in view of Stati.


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Conclusion

This response has addressed all of the Examiner's grounds for rejection. The rejections based on prior art have been traversed. Reconsideration of the rejections and allowance of the claims is requested.

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